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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Great Mother's Goods, Inc.
v.
Lynette M. Hegeman

Cancellation Nos. 30,015 and 30,164

Philip I. Frankel of Rifken, Frankel, Greenman, Friedman & Levine for Great Mother's Goods, Inc.

John P. Sutton, Esq. for Lynette M. Hegeman.

Before Cissel, Walters and Drost, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Great Mother's Goods, Inc. ("petitioner") has petitioned to cancel two registrations owned by Lynette M. Hegeman ("respondent"), namely, Registration No. 2,260,678 for the mark BELLY BUTTER for "cosmetic skin

cream for pregnant women," in International Class 3[1]; and Registration No. 1,980,659 for the mark BELLYBUTTER for "non-medicated herbal body salve/ointment," in International Class 3.[2]

As grounds for cancellation, petitioner asserts that respondent's marks, when applied to respondent's identified goods, so resemble petitioner's previously used marks BELLY BUTTER and GREAT MOTHER'S BELLY BUTTER for "non-medicated herbal salve/ointment"[3] as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Although inartfully drafted, we construe respondent's answer to both petitions for cancellation as denying the salient allegations of petitioner's claims and asserting as an affirmative defense that petitioner abandoned its mark by failing to use BELLY BUTTER as a trademark, alleging that petitioner uses GREAT MOTHER'S

[1] The mark registered on July 13, 1999, and the underlying application filing date was February 6, 1998. The registration includes a disclaimer of BUTTER apart from the mark as a whole. This registration is the subject of Cancellation No. 30,015.

[2] The mark registered on June 18, 1996, to Aristana Birch Firethorne and subsequently was assigned to Lynette M. Hegeman. The underlying application filing date was January 9, 1995. This registration is the subject of Cancellation No. 30,164.

[3] Petitioner asserts prior use since at least April 1993.

"to identify the source of its product," but uses BELLY BUTTER merely "to identify its product."

On July 10, 2000, the two proceedings herein were consolidated. However, the records of the USPTO show that on March 22, 2003, during the course of these consolidated cancellation proceedings, Registration No. 1,980,659, the subject of Cancellation No. 30,164, was cancelled because respondent failed to file an affidavit/declaration under Section 8 of the Trademark Act, 15 U.S.C. 1058.[4] Because respondent may not permit her involved registration to be cancelled under Section 8 after the commencement of a cancellation proceeding, we grant the petition to cancel against Registration No. 1,980,659 in Cancellation No. 30,164 with prejudice. Trademark Rule 2.134(b), 37 C.F.R. 2.134(b).[5] *See*

[4] Thus, it is unnecessary for the Board to decide whether petitioner's unpleaded argument in its brief, that respondent abandoned the mark in this registration, was, in fact, tried by the parties.

[5] Rule 2.134(b) gives the Board discretion to issue an order to respondent to show cause as to why this petition should not be granted with prejudice. However, petitioner made no such request and we find this step unnecessary in this case because our decision would remain the same even if we had considered the case on its merits. Respondent admitted that she has never used the telescoped mark BELLYBUTTER in Registration No. 1,980,659 in connection with her products; rather, she purchased the mark essentially to eliminate the registration of that mark as a possible bar to the registration of the BELLY BUTTER mark in her application that matured into Registration No. 2,260,678. [Hegeman testimony, pp. 53-55.] Nor has she submitted any evidence to establish the use of the BELLYBUTTER mark by her predecessor. Further, the telescoped mark BELLYBUTTER has essentially the same commercial impression as the identical two words, BELLY BUTTER, separated by a space, and the goods are substantially similar to both the goods in

Trademark Trial and Appeal Board Manual of Procedure (TBMP) (2d ed. June 2003) Section 602.02(b). In the remainder of this opinion we consider the merits of Cancellation No. 30,015.

The Record

The record consists of the pleadings; the files of the involved registrations; the testimony depositions by petitioner of Eugene Chappell, president and half owner of petitioner, and Katie Birchenough, petitioner's predecessor, both with accompanying exhibits; the testimony deposition of Lynette Hegeman, respondent, with accompanying exhibits; and an excerpt from an Internet website, submitted by respondent's notice of reliance. Both parties filed briefs on the case, but a hearing was not requested.

Analysis

Because petitioner does not have a registered trademark, we must first determine whether petitioner's alleged marks, BELLY BUTTER and GREAT MOTHER'S BELLY BUTTER, are inherently distinctive trademarks or, if not, whether the non-inherently distinctive mark (or marks)

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respondent's Registration No. 2,260,678 and to petitioner's goods identified by the mark BELLY BUTTER. Thus, we would find priority in favor of petitioner, as discussed in the body of this opinion with respect to Cancellation No. 30015, and a likelihood of confusion.

has acquired distinctiveness as a trademark indicating source. See *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 US 763 (1992). Under Section 2 of the Trademark Act, marks can be distinctive in two ways: "First, a mark is inherently distinctive if [its] intrinsic nature serves to identify a particular source." *Wal-Mart Stores, Inc. v. Samara Bros., Inc*., 529 U.S. 205, 210, 120 S.Ct. 1339, 1343 (2000). Word marks, such as BELLY BUTTER and GREAT MOTHER'S BELLY BUTTER, are held to be inherently distinctive when they are 'arbitrary' ('Camel' cigarettes), 'fanciful' ('Kodak' film), or 'suggestive' ('Tide' laundry detergent). *Id*. (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10-11 (2d Cir. 1976).

From the evidence of record, we conclude that, with respect to petitioner's goods, GREAT MOTHER'S BELLY BUTTER and BELLY BUTTER are at least suggestive marks and, thus, inherently distinctive, and that petitioner's use of GREAT MOTHER'S BELLY BUTTER and BELLY BUTTER in connection with its salve/ointment is valid trademark use.

In this regard, we find respondent has not established facts sufficient to support her pleaded affirmative defense concerning the mark BELLY BUTTER,

which fails regardless of whether we construe the defense as a contention that petitioner does not use the term BELLY BUTTER in the manner of a trademark or that BELLY BUTTER is merely descriptive as used in connection with petitioner's salve/ointment. Respondent argues in its brief that BELLY BUTTER is merely descriptive as used in connection with petitioner's goods, but not as used in connection with respondent's goods. Without addressing the apparent problems for respondent with this argument, we find that there is absolutely no evidence in the record in support of this position. Additionally, to the extent that respondent contends that petitioner has not used BELLY BUTTER in the manner of a trademark in connection with its goods, the evidence of petitioner's use of the mark, and the nature of that use on labels clearly contradicts respondent's contention.

Thus, we turn to the issue of priority. Petitioner's president, Eugene Chappell, testified to the use of the terms GREAT MOTHER'S BELLY BUTTER and BELLY BUTTER on jars containing its salve/ointment that are being sold throughout the United States by health food stores, independent direct stores and distributors and

retailers.[6] He testified from his personal knowledge to such use and sales from March 1997 to the date of his deposition; and he testified from business records under his control that were transferred from petitioner's predecessors to such use and sales from as early as 1993. Katie Birchenough, who developed the product sold as BELLY BUTTER and GREAT MOTHER'S BELLY BUTTER and founded the business that was eventually sold to petitioner, corroborated from her personal knowledge Mr. Chappell's testimony as to the early use of the marks. Additionally, the evidence, such as invoices, customer letters, articles and advertising, supports the conclusion that petitioner's predecessor first used the marks BELLY BUTTER and GREAT MOTHER'S BELLY BUTTER in connection with the described salve/ointment in April 1993. Notwithstanding respondent's arguments to the contrary, the evidence in the record clearly supports the conclusion that sales by petitioner and its predecessors of its herbal body salve/ointment under the marks were, and continue to be, bona fide sales in the ordinary course of business. The fact that petitioner's predecessor's revenues for 1993 sales of its BELLY BUTTER

[6] The record supports the conclusion that both marks, GREAT MOTHER'S BELLY BUTTER and BELLY BUTTER, are used to identify the source of petitioner's salve/ointment.

product were approximately $7600, resulting in a net operating loss for that year [Exhibit No. 15 to Ms. Birchenough's testimony], does not negate the use of the marks on goods sold in commerce.

Respondent's testimony and evidence establish that her first sale of her cosmetic skin cream under the BELLY BUTTER mark was a telephone order received on August 2, 1995 and shipped on August 11, 1995. Prior to that, during April or May, 1995, respondent received a "minibatch" of the skin cream in labeled jars that she distributed to friends. During this approximate time period, respondent also put samples of her product, with brochures showing the BELLY BUTTER mark, into gift bags distributed by a company to doctors' offices nationwide. There is no question from this record that petitioner has priority of use of its marks in connection with its products.

We turn to the issue of likelihood of confusion under Section 2(d). This determination must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). *See also In re Azteca Restaurant Enterprises, Inc.,* 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

With respect to the goods and services of the parties, respondent contends that the products are different to the extent that petitioner's product is a salve or ointment, whereas respondent's product is a cream. Both parties' products are used on the skin, contain some of the same ingredients, and are advertised largely to pregnant women to use on their stomachs to alleviate itching and minimize stretch marks. Even if petitioner's "non-medicated herbal salve/ointment" and respondent's "cosmetic skin cream for pregnant women" are not completely identical, we conclude that they are very similar and closely related products.

Further, respondent's identifications of goods is limited to use by pregnant women, and the evidence shows that petitioner markets its skin cream primarily to

pregnant women. Thus, the class of purchasers for the respective goods is the same. Respondent's identification of goods does not contain any limitations as to channels of trade. In fact, the evidence indicates that both parties sell their goods through distributors and retailers, telephone sales and on the Internet, which would appear to be normal trade channels for this type of product. Therefore, the channels of trade and class of purchasers of the parties' goods are the same.

Turning to the marks, it is obvious that respondent's mark BELLY BUTTER is identical to petitioner's mark BELLY BUTTER and it is unnecessary to determine the extent to which respondent's mark may be similar to petitioner's mark GREAT MOTHER'S BELLY BUTTER.

In conclusion, we find that petitioner has established its priority, and, in view of the fact that respondent's mark is identical to petitioner's BELLY BUTTER mark, their contemporaneous use on the substantially similar and closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Decision: The petition to cancel is granted.